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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/430,177	10/29/1999	UPVAN NARANG	100448.01	6878

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EXAMINER
WARE, TODD

ART UNIT	PAPER NUMBER
1615	26

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/430,177	Applicant(s) NARANG ET AL.	
	Examiner Todd D Ware	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 February 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51 and 76-144* is/are pending in the application.

4a) Of the above claim(s) *13,14,26-49,54-110 and 122-144* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12,15-25,50,51 and 111-121* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Receipt of response to restriction requirement filed 2-28-03 and request for extension of time (granted) filed 9-13-02 is acknowledged.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 11-13-02 has been entered.

Election/Restrictions

2. Applicant's election with traverse of group I in Paper No. 25 is acknowledged. The traversal is on the ground(s) that the search and examination could be conducted undue burden on the Examiner. This is not found persuasive because burden is shown by distinctness of the subclasses. Applicant's comments pertaining to previous search and examination are not found persuasive because upon reconsideration, the Examiner finds it necessary to issue restriction because of different subclasses as well as one-way distinction shown in the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 4, 13-14, 26-49, 54-110, and 122-144 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 25.

Specification

4. The incorporation of essential material in the specification by reference to a hyperlink is improper (MPEP 608.01(a)). Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

5. The attempt to incorporate subject matter into this application by reference to the hyperlink on page 14 is improper because the attempt to incorporate subject matter into the patent application by reference to a hyperlink and/or other forms of browser-executable code is considered to be an improper incorporation by reference.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3 and 15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Casey et al (4,716,203; hereafter '203).

8. '203 discloses suture thread that is dried after having been dipped into polymer solution of polymer dissolved in methanol and an initiator (abstract; C 3, L 55-64; examples 1 and 26).

9. Claims 1-2 and 15-16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Engelson et al (5,531,715; hereafter '715).

10. '715 discloses catheters that are dried after having been coated with polymer that is dissolved in methanol and an initiator (abstract; C 4, L 31-67).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 1-12, 15-25, 50-51 and 111-121 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Engelson et al (5,531,715; hereafter '715) in view of Clark et al (WO 97/31598; hereafter '598) or Engelson et al (5,531,715; hereafter '715) in view of Leung (WO 96/40797; hereafter '797).

15. '715 teaches catheters that are dried after having been coated with polymer that is dissolved in methanol and an initiator (abstract; C 4, L 31-67). '715 does not specifically set forth the instant polymerization initiators of the instant dependent claims.

16. '598 and '797 teach catheters/applicator tips/applicators for application of medical adhesive compositions and methods for their making with the polymerization initiators of the instant claims. The applicators and applicator tips of '598 and '797 comprise the instant porous polymers and can also comprise antibacterial agents. '598 and '797 also meet the requirement where the method of making utilizes a vacuum as they disclose heating the applicator tip in a vacuum oven.

Response to Arguments

17. Applicant's arguments filed 11-13-02 have been fully considered but they are not persuasive. Applicants argue that the instant claims are non-obvious on the basis that the instant specification provides data demonstrating unexpected results. The instant motivation for combining is not on the basis of choosing methanol vs. other solvents that are homologs. Therefore, the Declaration under 37 C.F.R. filed 8-13-02 is not persuasive.

18. Arguments' arguments regarding instant claim 50 are not persuasive. It is agreed that the reference states "subsequent to application of the initiator," however it is not agreed that this is a step apart from applying at least one agent from the instant group. Indeed the reference specifically states that the medium is impregnated (applied to) in the applicator tip in this fashion, page 18, lines 10-11. Thus, this step is not separate from application of an agent. As applied to the instant rejection, applicant further argues that the Office Action (Final Rejection of 3-13-02, Paper # 17) does not describe why one of ordinary skill would have substituted the claimed use of vacuum or

pressure for the disclosed use of spraying, dipping, or brushing. The rejection is on the basis that the prior art does not set apart the step of heating in a vacuum oven from these steps and instant claims do not exclude such steps.

19. **Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Engelson et al (5,531,715; hereafter '715) in combination with Clark et al (WO 97/31598; hereafter '598) and further in combination with Ren et al (5,942,554; hereafter '554) or Engelson et al (5,531,715; hereafter '715 in combination with Leung (WO 96/40797; hereafter '797) and further in combination with Ren et al (5,942,554; hereafter '554).**

20. '715, '598, and '797 are all relied upon for all that they teach as stated previously. While teaching antimicrobial, antiviral and antifungal agents, these references do not teach crystal violet as a polymerization initiator.

21. '554 is relied upon for teaching crystal violet as a polymerization initiator in polymer compositions.

22. Accordingly, it would have been obvious to one skilled in the art at the time of the invention to combine these teachings and substitute crystal violet with the motivation of initiating polymerization and further on the basis of availability of initiators.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd D Ware whose telephone number is (703) 305-1700. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703)308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

tw
May 19, 2003

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600